REMARKS/ARGUMENTS

Examiner Interview

Applicants thank Examiner Vivlemore for the courtesy extended to their attorney, John Gase, during the telephonic interview held on June 1, 2005. During the interview, the restriction requirement as to the sequences recited in claims 6, 7, 16, and 17 were discussed. The substance of that discussion is as set forth herein.

Summary of the Office Action

The Office Action sets forth a restriction requirement as between product and process claim as follows:

(I) claims 1-26, drawn to a composition for the inhibition of translation of a Mect1-MAML2 chimeric gene, and

(II) claims 27-34, drawn to a method of inhibiting translation of a Mect1-MAML2 chimeric gene.

The Office Action states that if the Applicants elect the product claims (i.e., claims 1-26) and the product claims are subsequently found allowable, any withdrawn process claims that depend from or otherwise include all of the limitations of the allowable product claim will be rejoined.

The Office Action sets forth a second restriction requirement as to the nucleotide sequences recited in claims 6, 7, 16, and 17. Specifically, the Office Action requires the Applicant to elect a single nucleotide sequence from among the several sequences recited in these claims. As discussed in greater detail below, it is the Applicants' understanding, after discussing the matter with the Examiner, that the restriction requirement is a provisional restriction requirement subject to a finding that a linking claim is not allowable. If a linking claim is found to be allowable, the restriction requirement will be withdrawn.

Election of Claims

Applicants elect, with traverse, the claims of Group I (claims 1-26) for prosecution. Furthermore, Applicants provisionally elect, with traverse, the nucleotide sequence of SEQ ID NO: 5 for prosecution. Claims 1-6, 8-17, and 20-34 read on the provisionally elected sequence. Reconsideration of the requirements for restriction is respectfully requested for the reasons discussed below.

Discussion of the Restriction Requirement as Between Product and Process Claims

A restriction requirement is proper only if (1) the inventions are independent or distinct as claimed, and (2) examination of the claims of one group with another group would pose a serious burden on the Examiner even though the groups are directed to distinct or independent inventions. Allegations that a claimed invention satisfies these criteria must be supported by reasoning and/or examples.

Applicants respectfully submit that the restriction requirement severing Groups I and II is improper because the nature of the claims is such that any burden encountered in searching the groups together would, at most, be slight (and certainly not "serious"). In this respect, the claims of Group I are directed to a composition. The claims of Group II are directed to a method of using the composition of Group I. If the composition of elected Group I is determined to be patentable, then the method of use claims of Group II also must be novel and unobvious. As such, any search and consideration of the claimed subject matter of Group I will necessarily overlap the search and consideration of the claimed subject matter of Group II.

For the foregoing reasons, this restriction requirement should be withdrawn.

Discussion of the Provisional Restriction Requirement as Between Sequences

The Office Action sets forth a restriction requirement as to the nucleotide sequences recited in claims 6, 7, 16, and 17, but fails to acknowledge that all such claims depend from claim 1 and that claim 1 is, therefore, generic to and links the subject matter of these claims. During the aforementioned interview, the Examiner agreed that at least claim 1 was a linking claim and indicated that the restriction requirement should be modified as appropriated.

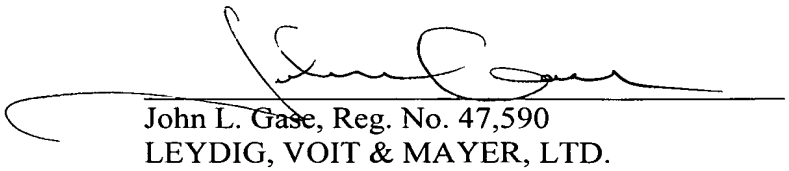
In accordance with MPEP Section 809.03 and form paragraph 8.12 referred to therein, the restriction requirement as to the linked inventions is subject to a finding that the linking claim is not allowable. If the linking claim is found to be allowable, the restriction requirement as to the linked inventions shall be withdrawn, and any claims depending from or otherwise including the limitations of the allowable linking claim will be entitled to examination. Furthermore, the failure to provide for the examination of generic "linking" claims effectively constitutes a rejection of the generic claims under 35 U.S.C. § 121, which deprives the applicant from the right to claim an invention as best he sees fit and is, therefore, improper. See, e.g., In re Weber, 580 F.2d 455, 458-59, 198 U.S.P.Q. 328,331-332 (C.C.P.A. 1978) (finding that "an applicant has a right to have each claim examined on the merits ....If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim.").

The Applicants disagree with the provisional restriction requirement on the grounds that the Office Action does not provide sufficient evidence that there would be any undue burden on the Examiner in the absence of restriction. Applicants have elected SEQ ID NO: 5; however, it would not be an undue burden on the Examiner to examine other sequences along with SEQ ID NO: 5. For example, SEQ ID NO: 2 contains SEQ ID NO: 5 (i.e., SEQ ID NO: 5 is a fragment of the larger nucleotide sequence of SEQ ID NO: 2). Similarly, SEQ ID NOs: 8 and 9 are near complements to SEQ ID NO: 5. Accordingly, the Applicants request that SEQ ID NOs: 2, 5, 8, and 9, or at least SEQ ID NOs: 2 and 5, be examined together, and that the provisional restriction requirement be withdrawn as to these claims.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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